

### **REMARKS**

The present application relates to hybrid maize plant and seed 36N70. Claims 5-8, 12, 20-21, 25, 33, and 41-58 have been canceled. Claims 9-11, 13-19, 22-24, 26-32, and 34-40 were previously canceled in the Amendment After Final submitted on May 27, 2003. Claims 1 and 2 have been amended. Claims 59-72 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. No new matter has been added by the present amendment. Applicants respectfully request consideration of the following remarks.

### **Detailed Action**

#### ***A. Status of the Application***

Applicants acknowledge the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicants further acknowledge that except for the remaining indefiniteness rejection against claims 8 and 21, the outstanding indefiniteness rejection, the new matter rejection, and the enablement rejection have been withdrawn. In addition, Applicants have amended the specification to clarify the deposit language and remove the blank lines by adding the appropriate ATCC Accession Nos.. A copy of the ATCC deposit receipts is included in this response. No new matter has been added.

### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 8 and 21 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, as stated on page 2 in the Office Action mailed on February 25, 2003.

Applicants have canceled claims 8 and 21, thus alleviating this rejection.

Claim 58 stands rejected as indefinite for the recitation "no statistically significant variation from 36N70".

Applicants have now canceled claim 58, thereby alleviating this rejection.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 8, 12, 21, 25 and 43-58 remain rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on page 5 in the Office Action mailed February 25, 2003.

Applicants respectfully traverse this rejection. However, in an effort to expedite prosecution, Applicants have canceled claims 8, 12, 21, 25 and 43-58, thus alleviating this rejection. Applicants have added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and put the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicants respectfully submit the claims now come within the purview of the written description requirement and request reconsideration.

Claims 8, 12, 21, 25 and 43-58 remain rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention, as stated on page 5 in the Office Action mailed February 25, 2003.

Applicants respectfully traverse this rejection. However, in an effort to expedite prosecution, Applicants have canceled claims 8, 12, 21, 25 and 43-58 thereby alleviating this rejection. Applicants have added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and put the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicants respectfully submit the claims now come within the purview of the enablement requirement and request reconsideration.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections to claims 8, 12, 21, 25 and 43-58 under 35 U.S.C. § 112, first paragraph.

**Summary**

Applicants acknowledge that claims 1-7, 20, 33 and 41-42 are allowed.

Applicants further acknowledge that claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are deemed free of the prior art. The Examiner further states the prior art fails to teach or fairly suggest the particularly claimed maize plants with their unique complement of genotypic and

morphological characteristics, or methods of using them. This clearly indicates that hybrid maize plant 36N70 as a whole is considered to be distinguishable from the prior art for the purposes of novelty and non-obviousness. Therefore, Applicants respectfully submit that the deposit of the representative seed of 36N70 and inbred parents GE570937 and GE501400 should satisfy the description requirement. In light of the above, Applicants respectfully submit that the rejections under 35 U.S.C. § 112, first paragraph are improper and requests reconsideration and withdrawal of these rejections.

Applicants further acknowledge that claims 59-72 have been agreed upon as allowable by Supervisory Patent Examiner Amy Nelson as aforementioned, thereby placing these claims in form for allowance. Applicants have canceled all non-allowable claims thereby placing the application in condition for allowance and have complied with all requirements of form set forth in previous office actions.

#### **Conclusion**

In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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